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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/888,031  
Filing Date: June 25, 2001  
Appellant  
(s): TARBET, KENNETH H.

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Rodney B. Carroll  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed February 17, 2009 appealing from the Office action mailed October 17, 2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 is not clear because steps in claim do not produce any results of the preamble.

Claim 7, last limitation teaches “fashioning the third table with the identifier”.

It is unclear as to what the fashioning the third table had to do with functionality of this invention.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 7, 9, 10 and 16 – 25 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Number 5,649,114 issued to David Deaton et al. (“Deaton”).

With respect to claim 7, Deaton teaches method of improving customer loyalty via real time generation and provision of a customer incentive report from a point of sale (column 4, lines 54 – 61), said method comprising:

utilizing a computer to execute a plurality of steps, the steps comprising (see Figs. 2, 10A, Deaton);

selecting a product information related to product (see col. 68, lines 43-45, Deaton);

storing a purchase information related to the purchase of the product by a customer (see col. 68, lines 45-55, Deaton);

storing a customer information related to the customer, the customer information associating the customer with the purchase (see col. 69, lines 9-20 et seq, Deaton);

storing a promotion information related to a promotion of the product, the promotion being independent of the customer information, wherein the promotion information includes both current and future promotion incentives (column 90, lines 36 – 50 and column 120, lines 12 – 29);

determining an intersection of the promotion information, the purchase information, and the customer information and storing the intersection in a database as the customer incentive report (see col. 90, lines 36-50, Fig. 35, Deaton);

wherein the database comprises a first table containing the product information second table comprising the purchase information, and a third table comprising the promotion information and a reference to a row of at least one table in the database (see col. 93, lines 5-35, Fig. 38, Deaton); and,

following the determining step (see Figs. 10A, 35, Deaton)) step:

fashioning the second table responsive to an item identifier attribute of the first table (see col. 104, lines 20-24, Deaton); and

picking at least one row from first table (see col. 100, lines 10-25, Deaton); and,

receiving an identifier of a first input table comprising at least a portion of one of the first tables, the first input table comprising a plurality of rows, at least one row consisting of at least one selected from an item effective identifier and a user effective identifier (see col. 100, lines 10-25, Deaton); and

fashioning the third table with the identifier (see col. 104, lines 20-24, Deaton).

As to claim 9, Deaton teaches the delivery step comprises delivery of a computer-readable copy of the customer incentive report to the corresponding user (column 118, lines 28 – 35).

As to claim 10, Deaton teaches the delivery step comprises delivery of a printed copy of the customer incentive report to the corresponding user (see col. 118, lines 28-35, Fig. 17A and B, Deaton).

As to claims 16 – 19, the computer readable copy of the customer incentive report includes current incentive offers, future incentive offers, or a combination thereof, the offers disclose pricing and wellbeing information (column 118, lines 28 – 38 and column 119, lines 4 – 50).

As to claims 20 – 23, the printed copy of the customer incentive report includes current incentive offers, future incentive offers, or a combination thereof, the offers disclose pricing and wellbeing information (column 118, lines 28 – 38 and column 119, lines 4 – 50).

As to claim 24 and 25, customer incentive report includes customer loyalty program information (column 7, lines 31 – 50).

#### **(10) Response to Argument**

Appellant's main arguments regarding the rejection of claims 7, 9, 10 and 16 – 25:

Argument No. 1: Appellant argues that Examiner has based his Section 112 rejection on a misunderstanding of M.P.E.P. Section 706.03(d) and the improper conclusion that claim 7 is a "use" claim. M.P.E.P. Section 706.03(d) is titled "Rejections Under 35 U.S.C. 112, Second Paragraph." See M.P.E.P. § 706.03(d) and a review of Paragraph 7.34.01 reveals that a Section 112, second paragraph rejection must also include at least one of the form paragraphs 7.34.02 - 7.34.11 (Page 9, The First and Third Paragraph, Brief);

Argument No. 2: Appellant argues that Deaton does not teach the "real time generation and provision to a customer of a customer incentive report remote from a point of sale," as recited in claim 7 (Page 12, The First Paragraph, Brief); and

Argument No. 3: Deaton does not anticipate the instant claims because Deaton does not expressly disclose all of claim 7's elements (Page 12, The First Paragraph, Brief).

**Examiner's Response to Arguments:**

In response to Argument No. 1:

In response to Appellants' argument, ¶ 7.34.01 Rejection, 35 U.S.C. 112, 2nd Paragraph, Failure To Particularly Point out and Distinctly Claim (Indefinite) discloses Claim rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This form paragraph **should be followed** by one or more of the following form paragraphs 7.34.02 - 7.34.11, **as applicable**. **If none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied.** Whenever possible, identify the particular term(s) or limitation(s) which render the claim(s) indefinite and state why such term or limitation renders the claim indefinite. If the scope of the claimed subject matter can be determined by one having ordinary skill in the art, a rejection using this form paragraph would not be appropriate. See MPEP §§ 2171 - 2174 for guidance.



Examiner fulfills the requirement of 35 U.S.C. 112, 2nd Paragraph by giving a full explanation as to why examiner thought the claim should be indefinite. As above, the form paragraph should be followed as applicable (but it is not must). MPEP also states, if none of these form paragraphs are appropriate, a full explanation of the deficiency of the claims should be supplied.

Since, examiner could not find any word or term “fashioning” and “real time” or “real time generation” in the entire specification, examiner interpreted these terminologies as one of ordinary skill in the art would interpret. Real time as to point of sale and fashioning as to organizing and/or maintaining database. With the claim steps, one of ordinary person in the art should question how customer loyalty has to do with fashioning the table or fashioning the third table.

Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification.

#### MPEP 2111 Claim Interpretation; Broadest Reasonable Interpretation

During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The court found that applicant was advocating ... the impermissible importation of subject matter from the specification into the claim.). See also In re

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Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (The court held that the PTO is not required, in the course of prosecution, to interpret claims in applications in the same manner as a court would interpret claims in an infringement suit. Rather, the “PTO applies to verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant’s specification.”).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999).

In response to Argument No. 2:

In response to Appellants’ argument, Examiner respectfully submits that Deaton teaches Customer incentive report as, the system generates coupons or issue incentives to induce that higher level of performance by the customer. The performance of a customer is tracked and incentives are modified based upon the criteria of performance such that incentives are added or subtracted (column 71, lines 26 – 30).

Deaton’s transaction terminals 120 are each located at a point-of-sale (such as a grocery store checkout stand). Transaction terminals 120 are used to communicate information to transaction processor 112 for check transaction processing and customer database management. A transaction terminal transmits a request (including a function code identifying the requested function together with other request data) to the

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transaction processor, which processes the request and returns an appropriate response. Deaton, further, teaches prior credit verification systems that requires connecting a point-of-sale terminal through telephone lines to a remote transaction processing system similar to remote from a point of sale or KIOSK as argued and as claimed by the Applicant. The system and method of the invention also provides automatic targeting of individual customers based upon their shopping history. Thus, at the point-of-sale and remote location, coupons or other incentives (**reports**) may be generated (in **real time**) which are specifically targeted to a specific customer based upon his or her prior history.

In response to Argument No. 3:

In response to Appellants' argument, Examiner points to the above explanation and further, Deaton provides automatic targeting of individual customers based upon their shopping history and at the point-of-sale, coupons or other incentives may be generated (see column 7, lines 31 – 35). Deaton discloses a system and method for customer promotion. A terminal enters a customer's identification code, along with customer transaction data, at the point-of-sale. A memory stores a database of previously entered customer identification codes and transactions data. Circuitry is provided for generating a signal representative of a customer's shopping history, wherein incentive coupons may be issued to customers in dependence upon the signal (see abstract).

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**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Shahid Al Alam/

Primary Examiner, Art Unit 2162

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